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370 SEVENTEENTH STREET  
DENVER, CO 80202-5647

EXAMINER

LINN, ERIC H

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2859

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/873,111

ALBERT, DAVID M.

Examiner

Eric H Linn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 29-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28, and 44, drawn to an angulator device, classified in class 33, subclass 509.
  - II. Claims 29-43, drawn to a method for locating a bowler's positive axis point on a bowling ball, measuring the ball's weight block angulation and locating a bowler's grip center, classified in class 33, subclass 452.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method claimed in Group II can be practiced by another materially different apparatus such as one which does not include the structural limitations stated in Group I, e.g., at least four arms, partially spherical base portion, etc.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Lee Osman on 6/10/2002 a provisional election was made without traverse to prosecute the invention of group I, i.e., a bowling ball angulator, claims 1-28, and 44. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### *Claim Objections*

5. Claims 1-7, 20, and 27 are objected to because of the following informalities:

- a) In claim 1: "said angle indicator arms" lacks antecedent basis.
- b) In claim 5: "said at least four indicator arms" lacks antecedent basis.
- c) Claims 20 and 27 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 19 and 26, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 2-7 are rejected due to their dependency on claim 1.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language is confusing because the bowling ball is used to determine the length of the arms, however, the bowling ball has not been positively claimed and, according to the specification, it is not part of the device to which the claims are directed.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 6, 7, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Cannon (US 5732474).

Regarding claims 1 and 44:

Cannon discloses a device comprising the following:

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a base portion 14 having a center 20 adapted to rest on a curved surface, the perimeter of said base portion including degree indicators 12; and

at least four arms (figure 2) adapted to substantially rest on the curved surface, said arms including length measurement indicators (figures 1-3), said angle indicator arms connected with and extending from said base portion;

wherein at least two of said angle indicator arms are adapted to rotate about the center of said curved base portion (figure 2).

Regarding claims 2, 4, 6, and 7:

Cannon discloses the device described above including the following:

at least two of said arms are formed integrally with said base portion (figure 1);

each of said arms is constructed of a flexible material;

said base portion has a partially spherical shape (figure 1);

at least two of the said arms extend in opposite directions from the center (figure 2).

With respect to the preamble of the claims:

the preamble of these claims do not provide sufficient patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon.

Cannon discloses the device described above in paragraph 9.

Cannon does not disclose the plurality of arms extending more than halfway down a bowling ball.

However, the limitations in this claim, absent any criticality, are only considered to be the “optimum” length of the plurality of arms of the angulator disclosed by Cannon, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980), and since the bowling ball is not considered to be part of the device as stated above in paragraph 7.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon in view of Albright, et al. (US 3096586) [hereinafter Albright].

Cannon discloses the device described above in paragraph 9.

Cannon does not disclose the alignment of the indicator arms with the center of the base portion.

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Albright shows a device including the alignment of the indicator arms with the center of the base portion (figures 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Cannon to align the indicator arms with the center of the base portion, as disclosed by Albright, since this would allow one to sketch a line that is exactly in the center of the surface on which the base is resting.

13. Claims 8-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon and Albright as applied to claim 5 above, and further in view of Amburgey (US 3161041).

Regarding claims 8, 9, and 11-28:

Cannon and Albright disclose the device described above in paragraph 12.

Cannon and Albright as modified above do not disclose a collar that attaches the indicator arms.

Albright discloses a collar 14 that attaches the indicator arms.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a collar as disclosed by Albright to the device disclosed by Cannon and modified by Albright since this would allow for the attachment of the indicator arms disclosed by Cannon and Albright.

Cannon and Albright do not disclose a curved base portion, curved arms, or a substantially open middle portion.



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Amburgey shows a device including a curved base portion (figure 5), curved arms (figure 4), and a substantially open middle portion (figure 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Cannon and Albright to have a curved base portion, curved arms, and a substantially open middle portion, as taught by Amburgey, since this would allow the device to be used with a curved surface because it will rest on a curved surface more readily, the curved arms would allow for easy marking of the curved surface and the substantially open middle portion would allow one to see more of the surface being marked.

Regarding claim 10:

Albright, Cannon and Amburgey disclose the device described above in paragraph 13.

Albright, Cannon and Amburgey do not disclose the plurality of arms extending more than halfway down a bowling ball.

However, the limitations in this claim, absent any criticality, are only considered to be the “optimum” length of the plurality of arms of the angulator disclosed by Cannon, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy, manufacturing costs, etc. See In re Boesch, 205 USPQ 215 (CCPA 1980), and since the bowling ball is not considered to be part of the device as stated above in paragraph 7.

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*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents show bowling ball measurement devices:

US Patent 5042163 to Sposato

US Patent 5603165 to Bernhardt et al.


US Patent 5813129 to Tseng

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric H Linn whose telephone number is 703-305-4745. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on 703-308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9318 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

EHL  
June 12, 2002

  
Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800